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Kimberly A. Benjamin
Kimberly A. Benjamin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

7p
3-19-2

In the application of:

Benjamin D. PLESS

Serial No.: 09/543,264

Filing Date: April 5, 2000

For: NEUROSTIMULATOR INVOLVING
STIMULATION STRATEGIES AND
PROCESS FOR USING IT

Examiner: R. Bradford

Group Art Unit: 3762

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the Office Action -- a Restriction Requirement and requirement for election of species -- (Paper No.6) dated January 11, 2002.

RESTRICTION REQUIREMENT

The Examiner indicates that the claims as grouped below are independent and distinct inventions:

- I. Claims 1-65, drawn to the method and apparatus for treating neurological conditions, classified in class 607, subclass 45.

II. Claims 66-73, drawn to the method for treating neurological conditions by using at least one electrical burst to detect electrical activity, classified in class 067, subclass 45.

III. Claims 74-76, drawn to method for treating neurological conditions with the use of electrodes, classified in class 607, subclass 45.

IV. Claims 77-81, drawn to method for treating neurological conditions by using hyperpolarizing pulse, classified in class 607, subclass 45.

In support of the Restriction, the Examiner suggests apparently the Group I claims are drawn to a combination that is useful with subcombinations found in Groups II, III, and IV and further that Groups II, III, and IV are distinct from each other in the aggregate.

Solely for the purpose of complying with 37 CFR 1.143, Applicant elects the Group I invention (claims 1-65) with traverse and requests reconsideration of the Requirement.

Applicant notes that each of the claims, as grouped, is classified in Class 607, subclass 45. It is unlikely that the USPTO classification index would be so blind to the concept of "separate status in the art" that those inventions having clear "separate status" would be found in the same subclass. Consequently, because each Group is placed in the same subclass, the standards required by the MPEP have not been met -- note that in MPEP 605.03(c), additional proof beyond urged "notoriety" of "separate" status is required. In the absence of a completely stated basis for the Restriction requirement, Applicant requests withdrawal of the Requirement and further requests that all of the claims be examined together.

ELECTION OF SPECIES REQUIREMENT

The Applicant is further required to elect one of four species. The Examiner notes:

"This application contains claims directed to the following patentably distinct species of the claimed invention: Embodiments 1-4 represented by the pulse parameters being pulse-to-pulse, pulse amplitude, hyperpolarizing repulse, and pulse width, respectively".

Solely for the purpose of complying with 37 CFR 1.143, Applicant elects the **pulse-to-pulse** - pulse parameter species again with traverse and requests reconsideration of the election of species requirement.

The MPEP allows for election of species during prosecution when "there is no disclosure of relationship between species..." See MPEP 808.01(a). There is a disclosed relationship amongst the species and that relationship is found in the application. In the absence of any PTO comment or holding relating to such disclosure and to such a relationship, the basis for the election of species requirement has not been established and the election of species requirement must be withdrawn.


Finally, each of claims 1-65 is generic to the elected species since the pulse to pulse - pulse parameter may be varied in each invention recited by each of the Group I claims.

SUMMARY

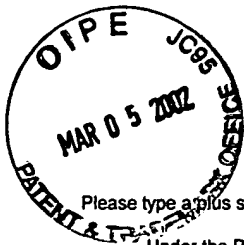
Applicant disagrees that the Restriction Requirement and the Election of Species Requirement have been stated with the particularity required by the Law, Rules, and MPEP and requests that they be withdrawn and that all of the claims be examined on the merits.

Should the Examiner have any questions or requests, he is urged and invited to contact Applicant's attorney at the number listed below.

Dated: February 19, 2002

Respectfully submitted,

By: E. Thomas Wheelock
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**TRANSMITTAL
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4

Application Number

09/543,264

Filing Date

April 5, 2000

First Named Inventor

Benjamin D. PLESS

Group Art Unit

3762

Examiner Name

R. Bradford

Attorney Docket No.

459992000700

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SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm

Morrison & Foerster LLP, 755 Page Mill Road, Palo Alto, CA 94304-1018

or

Individual Name

E. Thomas Wheelock (Reg. No. 28,825)

Signature

Date

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Kimberly A. Benjamin

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